

### REMARKS

Applicants respectfully request the Examiner to reconsider the present application in view of the following remarks.

#### Status of the Claims

Claims 3, 5, and 6 are pending in the present application. In view of the following remarks, the Examiner is respectfully requested to withdraw all rejections and allow the currently pending claims.

#### Issues under 35 U.S.C. § 103(a)

The Examiner has rejected claims 3, 5, and 6 under 35 U.S.C. § 103(a) as being unpatentable over Okada et al. '044 (US 2002/0035044) in view of Cody et al. '692 (US 6,322,692) and further in view of Hirano et al. '005 (US 6,459,005).

Applicants respectfully traverse, and reconsideration and withdrawal of the rejection are respectfully requested.

Okada et al. '044 disclose that the pour-point depressant is "ACLUBE 133" (paragraph [0334]). This pour-point depressant is the same one used in Examples 10-12 of the present specification (now comparative examples). As shown on Table 7 at page 38 of the present specification, the "ACLUBE 133" pour-point depressant has a melting point of -11.4°C.

In addition, the Examiner is respectfully requested to review the enclosed 37 CFR § 1.132 Declaration of Ryousuke Kaneshige, one of the present inventors as well as an inventor of Okada et al. '044. In the enclosed Declaration, Mr. Kaneshige states that the pour-point depressants of Okada et al. '044 have a melting point higher than -13°C and confirms that the "ACLUBE 133" pour-point depressant has a melting point of -11.4°C.

As such, Okada et al. '044 do not meet each and every limitation of claim 3, from which claims 5 and 6 depend. Specifically, claim 3 recites, *inter alia*, "***a pour-point depressant (C) having a melting point as measured with DSC of not higher than -13°C***" (emphasis added).

Cody et al. '692 only disclose a viscosity index, a sulfur content, and a saturated hydrocarbon content. Similarly, Hirano et al. '005 do not overcome the deficiencies of these references. As such, the combination of Okada et al. '044, Cody et al. '692, and Hirano et al. '005 fail to disclose each and every limitation of independent claim 3.

To establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be disclosed by the prior art or known in the art. As discussed above, the cited references fail to disclose all the claim limitations of independent claim 3, and those claims dependent thereon. Therefore, a *prima facie* case of obviousness has not been established, and withdrawal of the outstanding rejection is respectfully requested.

Moreover, relevant to this § 103(a) rejection, *Graham v. John Deere*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966) has provided the controlling framework for an obviousness analysis, wherein a proper analysis under § 103(a) requires consideration of the four *Graham* factors. One such factor includes the evaluation of any evidence of secondary considerations (e.g., commercial success; unexpected results). 383 U.S. at 17, 148 USPQ at 467. In this regard, Applicants respectfully submit that the present invention has achieved unexpected results, whereby such results rebut any asserted *prima facie* case of obviousness. See *In re Corkill*, 711 F.2d 1496, 226 USPQ 1005 (Fed. Cir. 1985). Also, the comparative showing need not compare the claimed invention with all of the cited prior art, but only with the closest prior art. See MPEP 716.02(b) and 716.02(e).

According to MPEP 2145, rebuttal evidence and arguments can be presented in the specification, *In re Soni*, 54 F.3d 746, 750, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995). Office personnel should consider all rebuttal arguments and evidence presented by Applicants. See, e.g., *Soni*, 54 F.3d at 750, 34 USPQ2d at 1687 (error not to consider evidence presented in the specification). Rebuttal evidence may also include evidence that the claimed invention yields unexpectedly improved properties or properties not present in the prior art. Rebuttal evidence may consist of a showing that the claimed compound possesses unexpected properties. *In re Dillon*, 919 F.2d 688, 692-93, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990).

Comparing Examples 4 and 7 with Examples 10 and 13 (which are now comparative examples), the lubricating oil composition of the present invention containing a pour-point depressant (C) and having a melting point as measured with DSC of not higher than -13°C has an unexpectedly low MRV. The above results are also shown when comparing Examples 5 and 8 with Examples 11 and 14 (also now comparative examples) and Examples 6 and 9 with Examples 12 and 15 (now comparative examples). Thus, due to the unexpected results as achieved by the present invention, the rejection has been overcome. Reconsideration and withdrawal of this rejection are respectfully requested.

As stated in *KSR International Co. v Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007), “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Furthermore, the mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art. *Id.* As described above, Applicants have shown that the present invention achieves unexpected and unpredictable results.

For the reasons given above, the combination of references does not render the present invention obvious because the cited references or the art as a whole do not disclose at least one feature of the present invention and its effects. Furthermore, the cited references or the knowledge in the art provide no reason or rationale that would allow one of ordinary skill in the art to arrive at the present invention as claimed. Any contentions of the USPTO to the contrary must be reconsidered at present.

### CONCLUSION

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Chad M. Rink, Reg. No. 58,258 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated:

**JAN 26 2009**

Respectfully submitted,

By 

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Attachment: Executed Declaration under 37 C.F.R. 1.132 by Ryousuke Kaneshige